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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,260	01/25/2005	Akemi Koketsu	JD-229 US	1402

7590 07/14/2005

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EXAMINER	
HUANG, MEI QI	
ART UNIT	**PAPER NUMBER**
1713	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/522,260	KOKETSU ET AL.	
	Examiner	Art Unit	
	Mei Q. Huang	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 2 is objected to because of the following informalities.

The selective formats of various groups are improper in that it is not clear whether the individual members in the group are selected in alternatives only or in both alternatives and combinations. In general, when the members in a group are individually chosen as alternatives, the format, "selected from A, B, ..., *or* X" or "selected from the group consisting of A, B, ..., *and* X", should be used; and when the members in a group are chosen both in alternatives and combinations, the format "selected from the group consisting of A, B, ..., X, *and* mixtures thereof" should be used. See MPEP 2173.05 (h). Applicants are requested to amend the selective formats of the instant claims according to the above guidance.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan et al. (US Pub. 2003/0130440).

The prior art to Kaplan et al. provides a thermosetting coating material which comprises a carboxyl-functional polyester or a polyacrylate (page 1, [0001]). And the

composition also comprises other additives, such as dispersing agents (Abstract). A comparison of the composition components between the prior art and the present application is shown in the following table.

US 2003/0130440 Page 2, [0027]-[0031]	US 2003/0130440 Page 2, [0027]-[0031]	The present application Claim 1
a) Methyl methacrylate	0-70 wt%	(c) 5-90 wt%
b) (cyclo)alkyl ester of acrylic	0-60 wt%	(a) 1-70 wt%
d) olefinic unsat. Carboxylic acid	1-60 wt%	(b) 5-50 wt%

As one can see, the prior art ranges overlap the instantly claimed ones. It has been consistently held that even a slight overlap in range establishes a *prima facie* case of obviousness. *In re Woodruff,* 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner,* 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

In regard to the limitation of the composition being able to be used for floors required by the instant claim 1, Kaplan et al. do not teach such an applicability. However, the courts have held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best,* 562 F.2d 1252, 1255, 195 USPQ 430. 433 (CCPA 1977); *Titanium Metals Corp. v. Banner.* 778 F.2d 775. 227 USPQ 773 (Fed. Cir. 1985). Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to the applicant to show that the prior art products do

not necessarily possess the characteristics of the claimed product, i.e. being able to be used for floors. See MPEP §§ 2112.01.

The courts have also held that the fact that a characteristic is a necessary feature or result of a prior-art embodiment is enough for inherent anticipation, event if that fact was unknown at the time of the prior invention. *In Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1320, 69 USPQ2d 1584, 1590 (Fed. Cir. 2004); and *In Atlas Powder Co. v. Ireco, Inc.,* 190 F.3d 1342, 1348-49 (Fed. Cir. 1999).

In regard to claim 2, Kaplan et als' monomers (b), (cyclo)alkyl esters of acrylic and/or methacrylic acid, include cyclohexyl methacrylate (page 2, [0032]).

With regard to the copolymer not being crosslinked by metal compounds required by the instant claim 3, Kaplan et al. disclose that the copolymer is crosslinked using a specific selected cross-linking agent, a masked β-hydroxyalkylaminde (page 1, [0001]). Kaplan et al do not use metal cross-linker.

As to claim 4, the rejection made for claim 2 described above in this Office Action would be applied herein to reject claim 4.

As to claims 5-6, Kaplan et als' carboxyl-functional polyester has a T_g of 30-80° C and a acid value of 20-100 (page 3, claim1), which overlap the instantly claimed T_g of 40-115° C and acid value of 60-150.

As to claims 7-9, the rejection made for claim 1 described above in this Office Action would be applied herein to reject claims 7-9.

Conclusion

The prior art made of record but not relied upon is considered pertinent to applicant's disclosure. The following references have been cited to show the state of the art with respect to the study of floor polishing composition.

US Patent 5,574,117 to Yoshida et al.

US Pub. 2004/0198880 to Ouchi et al.

US Patent 4,347,333 to Lohr et al.

US Patent 4,317,755 to Gregory

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mei Q. Huang whose telephone number is (571) 272-3549. The examiner can normally be reached on 8am - 4pm, Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mei Q. Huang
Examiner

July 8, 2005

DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700